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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,736	11/13/2003	Indran Naick	AUS920030776US1(4015)	2704
45557 7590 10/02/2008 IBM CORPORATION (JSS) C/O SCHUBERT OSTERRIEDER & NICKELSON PLLC 6013 CANNON MOUNTAIN DRIVE, S14 AUSTIN, TX 78749				
EXAMINER JEAN GILLES, JUDE				
ART UNIT		PAPER NUMBER		
2143				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/713,736

Applicant(s)

NAICK ET AL.

Examiner

JUDE J. JEAN GILLES

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 13 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- Paper No(s)/Mail Date _____

- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

This action is in Reply to communication filed on 06/17/2008.

Response to Argument

1. Applicant's arguments, see communication filed 06/17/2008, with respect to independent claims 22, 30, and 37 and their dependencies, have been fully considered and are persuasive. The rejection of claims 22-40 have been withdrawn.

Claim Rejections - 35 USC § 101

2. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

3. Claim 37-40 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding claim 37: Claim 37 recites the steps of “A machine-accessible medium containing instructions, which when executed by a machine, cause the machine to perform operations for selective transmission of an e-mail attachment for an email, comprising: selecting, by a sender, email attachment recipients, selectable notification recipients, and excluded recipients for the email to be sent, wherein the excluded recipients do not receive the email attachment; receiving, from, the sender, an instruction to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients; transmitting the email to the email

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attachment, recipients, the selectable notification recipients, and the excluded recipients; and receiving the email attachment by both the selectable notification recipients, who activated the selectable notification, and the email attachment recipients." These steps definitely recite a hardware (the machine) executing the computer software, but do not necessarily make the hardware (the machine) a part of the claim, thereby rendering the claim as recited only an abstract idea. The claim equates merely to a computer code or concept per se since *"instructions, which when executed by a machine"* in the context of the claimed invention are interpreted by the Examiner to represent intended use of computer code or concept, which does not have a practical application or tangible result.

Regarding claims 38-40: dependent claims 38-40 are also nonstatutory because of the reason mention for the rejection of claim 37, a base claim.

Suggested correction: Applicants are advised to amend as follows:

Amend claim 37 *"A machine-accessible storage medium containing instructions..." in accordance with steps i) and ii) of par. 0058 of the specification document.*

Or

Amend the specification document to remove step iii) of par. 0058.

Appropriate correction is required. The above noticed problems are just exemplary. Applicant is required to totally check the application for error and correct the same.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 22-40 are rejected under 35 U.S.C. 102(e) as being anticipated by
Marchionda, U.S. Patent No. 6,628,306

Regarding claim 22, Marchionda discloses:

A method, in a data processing system for selectively transmitting an email attachment of an email (fig. 7, and 8), the method comprising:

selecting, by a sender, email attachment recipients, selectable notification recipients, and excluded recipients for the email to be sent, wherein the excluded recipients do not receive the email attachment (figs. 7, and 8; column 7, lines 60-67, continue lines 1-12 of column 8);

receiving, from the sender, an instruction to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients (see abstract; see col. 4, lines 51-62; note the different options built from instructions that is the makeup of the selectable notification),

transmitting the email to the email attachment recipients, the selectable notification recipients, and the excluded recipients (col. 5, lines

6-27); and

receiving the email attachment by both the selectable notification recipients, who activated the selectable notification, and the email attachment recipients (see abstract, figs 3 and 4; col. 6, 57-67 and col. 7, 1-16).

23. The method of claim 22, further comprising prompting, in response to activating the selectable notification, to optionally add comments before the selectable notification recipients receive the email attachment (col. 8, lines 12-39).

24. The method of claim 22, further comprising prompting, in response to activating the selectable notification, the sender to locate the email attachment for the selectable notification recipients before the selectable notification recipients receive the email attachment (col. 8, 40-65).

25. The method of claim 22, further comprising receiving, by the excluded recipients, an indication in the email that the email had the email attachment despite the email attachment being unavailable to the excluded recipients (column 7, lines 60-67, continue lines 1-12 of column 8).

26. The method of claim 22, wherein receiving an instruction to add a selectable notification comprises inserting code in the form of a markup

language for allowing the selectable notification recipients to receive the email attachment (col. 9, lines 7-49).

27. The method of claim 22, wherein receiving an instruction to add a selectable notification comprises inserting, into the email, an icon linked to code for allowing the selectable notification recipients to receive" the email attachment (col. 1, 11-25, col. 6, 42-56).

28. The method of claim 22, wherein receiving an instruction to add a selectable notification comprises inserting, into the email, an icon linked to code for allowing the selectable notification recipients to receive the email attachment based on one or more preferences (col. 1, 11-25, col. 6, 42-56).

29. The method of claim 22, wherein the selecting the email attachment recipients comprises selecting persons the sender chooses to receive the email attachment with the email and without the selectable notification(column 7, lines 60-67, continue lines 1-12 of column 8).

30. A device in a data processing system for selective transmission of an e-mail attachment for an email (figs. 7, and 8), the device comprising:

an email client for composing the email to be sent to email attachment recipients, selectable notification recipients, and excluded recipients, wherein the excluded recipients do not receive the email attachment (column 7, lines 60-67, continue lines

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1-12 of column 8; see abstract);

a notification incorporator, in communication with the email client, to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients (figs. 7-9; see col. 4, lines 51-62);

a code associator, in communication with the notification incorporator, to associate code with the selectable notification for fetching then email attachment in the email to be sent to the selectable notification recipients (see abstract; see col. 4, lines 51-62); and

another email client for receiving the email attachment by both the selectable notification recipients, who activated the selectable notification, and the email attachment recipients (figs 3 and 4; col. 6, 57-67 and col. 7 1-16).

31. The device of claim 30, wherein the notification incorporator prompts a sender at the email client to select the email attachment recipients, the selectable notification recipients, and the excluded recipients (figs 7-9).

31. 32. The device of claim 30, wherein the notification incorporator comprises an icon selector for the selectable notification attachment (col. 1, 11-25, col. 6, 42-56).

33. The device of claim 30, wherein the notification incorporator comprises preferences associated with the email attachment (figs 7-9).

34. The device of claim 30, wherein the code associator comprises code comprising a markup language (col. 9, 8-49).

35. The device of claim 30, wherein the code associator comprises a code generator to generate code, upon activation of the selectable notification, in accordance with one or more preferences associated with the email attachment (col. 9, 8-49).

36. The device of claim 30, further comprising an attachment responder for prompting a sender before transmission of the email attachment to the selectable notification recipients, who activated the selectable notification (figs. 7-9).

37. A machine-accessible medium containing instructions, which when executed by a machine, cause the machine to perform operations for selective transmission of an e-mail attachment for an email, comprising: selecting, by a sender, email attachment recipients, selectable notification recipients, and excluded recipients for the email to be sent, wherein the excluded recipients do not receive the email attachment (figs. 7, and 8; column 7, lines 60-67, continue lines 1-12 of column 8);

receiving, from, the sender, an instruction to add a selectable notification for the email attachment to the email to be sent to the selectable notification recipients (figs. 7-9; see col. 4, lines 51-62);

transmitting the email to the email attachment, recipients, the selectable notification recipients., and the excluded recipients (col. 5, lines 6-27; see col. 4, lines

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51-62;); and

receiving the email attachment by both the selectable notification recipients, who activated the selectable notification, and the email attachment recipients (see abstract, figs 3 and 4; col. 6 57-67 and col. 71-16).

38. The machine-accessible medium of claim 38, wherein the operations further comprise instructions for prompting, in response to activating the selectable notification, to add comments and to locate the email attachment before the selectable notification recipients receive the email attachment (figs 7-9).

39. The machine-accessible medium of claim 38, wherein the instructions for receiving an instruction to add a selectable notification comprise inserting, into the email, code in the form of e markup language for allowing the selectable notification recipients to receive the email attachment (col. 9, 8-48).

32. 40. The machine-accessible medium of claim 38, wherein the instructions for receiving an instruction to add a selectable notification comprise inserting, into the email, an icon linked to code for allowing the selectable notification recipients to receive the email attachment optionally based on preferences attachment (col. 1, 11-25, col. 6, 42-56).

Conclusion

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5. ***This action is made Non-Final.*** Any inquiry concerning this communication or earlier communications from examiner should be directed to Jude Jean-Gilles whose telephone number is (571) 272-3914. The examiner can normally be reached on Monday-Thursday and every other Friday from 8:00 AM to 5:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tonia Dollinger, can be reached on (571) 272-4170. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-3301.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-0800.

Jude Jean-Gilles

/Jude J Jean-Gilles/

Primary Examiner, Art Unit 2143

JJG

September 26, 2008